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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/522,706 Confirmation No.: 7467

Applicant : Verena STANGL et al.
Filed : January 28, 2005
TC/A.U. : 1654
Examiner : Christina BRADLEY

Docket No. : 2958-128
Customer No. : 6449

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In the Office Action mailed 8 September 2006, the Examiner required restriction between seven Groups, each directed to a group of proteosome inhibitors. In response to this Office Action, Applicants elect Group II, claims 1-10 and 13-24 directed to modified peptide aldehydes for examination. This election is made with traverse. With respect to the species, Applicants elect N-carbobenzoxy-L-leucinyl-L-leucinyl-L-leucinal (also called zLLL, z-Leu-Leu-Leu-al or MG132). This election is also made with traverse. Claims 1-6, 8, 9, 13-19 and 21-23 read on the election of Group II and the elected species MG132.

Applicants note that many of the proteosome inhibitors of the present invention that are set forth in Groups I-V are derivatives of small peptides. These small peptide derivatives include (a) peptide derivatives which have a C-terminal expoxy ketone structure, (b) modified peptide aldehydes or boric acid derivatives, (c) peptides comprising an α,β,-epoxyketone-structure or vinyl-sulfones, (d) dipeptidyl-boric-acid derivatives and (e) peptidyl pinacol-esters. See for example claims 6 and 8. Applicants submit that these peptide derivatives relate to a single general inventive concept under PCT Rule 13.1 having the same or corresponding special technical features, i.e., proteosome inhibitors that are small peptide derivatives. This single general inventive concept is not disclosed in any of the prior art cited by the Examiner with respect to proteosome inhibitors. This prior art merely discloses small peptides, such as 10mers

and a lactone derivative. Accordingly, this prior art does not support a conclusion that the class of small peptide derivatives of the present invention is not a single general inventive concept. Thus, Applicants submit that these small peptide derivatives should comprise one group for purposes of restriction in accordance with 37 CFR 1.499. In view of these remarks, Applicants request that the restriction requirement be reconsidered and that Groups II, III, V and the peptide derivatives of Groups I and IV be combined into a single Group for examination.

In addition, Applicants believe that claims 10 and 24 directed to a proteosome inhibitor which interferes with gene expression may more properly belong with Groups VI and VII.

In view of the above arguments, it is requested that the restriction requirement imposed in the Office Action mailed 8 September 2006 be reconsidered and that the restriction of the proteosome inhibitors be regrouped so that all of the small peptide derivatives as set forth above be included in a single group.

Respectfully submitted,

By _____

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